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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,955	08/21/2003	Kazuo Okada	3022-0020	6676

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EXAMINER	
SHAH, MILAP	
ART UNIT	**PAPER NUMBER**
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/644,955	OKADA, KAZUO	
	Examiner	Art Unit	
	Milap Shah	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 January 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) *11-13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-13* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/2/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is in response to the amendments received on January 3, 2007 and January 18, 2007. The Examiner acknowledges the supplemental amendment to correct a typographical error. The Examiner also acknowledges that claims 1-5, 7, 9, & 10 were amended, no claims were canceled, and claims 11-13 were added. Therefore, claims 1-13 are currently pending.

Election/Restrictions

Newly submitted claims 11-13 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Newly submitted claims 11-13 are directed towards an invention regarding a method of displaying, controlling, and adjusting the display of symbols on a gaming machine. In contrast, the originally claimed invention was directed to a gaming machine having various components including a variable display, a stop control device, a shielding device, and other components. Therefore, Invention I (claims 1-10) and Invention II (claims 11-13) are patentably distinct for at least being subcombinations useable together, where Invention II, the method of displaying, controlling, and adjusting the display of symbols may be executed on the gaming machine of Invention II, however, it does not necessarily require the gaming machine of Invention II. Similarly, Invention I stands alone without the necessity of the claimed method of Invention II.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11-13 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

Claims 1 & 5 are objected to because of the following informalities: The first recitation of the phrase "under control of the CPU" in each of these claims should be "under the control of a central processing unit (CPU)" to avoid any lack of antecedent basis issues since the CPU was not previously introduced in the claims and acronyms should be completely spelled at the first use of said acronym. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or

claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13-16 of co-pending Application No. 10/697,256. Although the conflicting claims are not identical, they are not patentably distinct from each other because.

The Examiner submits the following table to more clearly support the non-statutory obviousness-type double patenting rejection. Claim 13 from 10/697,256 and Claim 1 from 10/644,955 are shown below, limitation for limitation, and it can be clearly seen that both applications are claiming the "same" subject matter.

In the instant application, the devices are under control of CPU, however, that is inherent in a gaming machine, thus, in 10/697,256 the various devices would naturally be under control of CPU or processing system within the gaming machine.

10/697,256 - Claim 13	**10/644,955 - Claim 1**
A gaming machine comprising:	A gaming device comprising:
variable display devices for variably displaying various symbols;	variable display device for varying a display of a plurality of symbols;
a lottery device for executing a lottery of a winning combination;	lottery device for executing a lottery for a prize pattern under control of the CPU;
a stop control device for performing stop control of variable display;	stop control device for controlling and stopping the variable display device under control of the CPU;
a stop control selection device for selecting a kind of control of the stop control device in reference to a result of the lottery;	stop control selection device for selecting a control type of the stop control device based on a result of the lottery under control of the CPU;
a shielding device for shielding approximately the whole area of the variable display devices, the shielding device being disposed in front of the variable display devices; and	shielding device for shielding a view of the variable display device under control of the CPU, the shielding device being disposed in front of the variable display device; and

a shielding control device for performing, in accordance with selection by the stop control device, switch control of the shielding device between a state enabling a player to visually recognize some of the symbols and another state disabling the player from visually recognizing some of the symbols; wherein the shielding control device performing, in accordance with a kind of stopping operation by the player, switch control between a first shielding state which is executing when the stopping operation matches the kind of the stop control device, and a second shielding state which is executing when the stopping operation does not match the kind of stop control device.	shielding control device for controlling the shielding device under control of the CPU to either state that a player can see the symbols or a state that the player cannot see the symbols so that a stopping order is indicated, by controlling the shielding device such that (i) a display area of a reel that is to be stopped is in the state that the player can see the symbols on the reel and (ii) display areas of the other reels that are not to be stopped are in the state that a player can not see the symbols on those reels.

The final limitation of the shielding control device in both claims are considered equivalent, such that based upon the stop control device the shielding state is determined and the player is able to visually recognize or not recognize some of the symbols. Since it appears that both applications encompass similar subject matter, it can be seen that the invention of 10/697,256 can be deduced from 10/644,955 and vise versa.

Therefore, the double patenting rejection is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa (JP Publication No. 2000-300729; translation previously provided) in view of Minoura (Japanese Patent Publication No. 07-124290; see attached machined English translation of the abstract, detailed description, claims and description of drawings).

Claims 1, 5-8, & 10: Nishikawa discloses the invention substantially as claimed including a gaming machine comprising a substantially transparent panel disposed on the display device (i.e. the panel on the front of the machine that provides transparent openings for a player to view the reels), a variable display device for varying displaying a plurality of symbols (i.e. gaming reels or drums), lottery device for executing a lottery for a prize pattern (i.e. random outcome), a stop control device for controlling and stopping the variable display device (i.e. a motor for stopping the reels), and a stop control selection device for selecting a control type of the stop control device based on a result of the lottery (i.e. setting the reels to stop at the correct positions corresponding to the random outcome) (see at least abstract, figures 3-5, and paragraphs 0002-009, 0013-0021 of English translation). Nishikawa also discloses shielding device and shielding control device for shielding a view of the variable display device, the shielding device being disposed in front of the variable display device (i.e. disable a player from viewing non-winning symbols via the liquid crystal display becoming opaque or colored in those positions, and enable a player to view the symbols associated with the winning pay line or winning combination so as to highlight the winning combination) See at least abstract, figures 3-5, and paragraphs 0002-0021 of English translation. With respect to the latter part of each limitation that requires the devices to be "under control of a CPU", it's inherent to the stand alone gaming machine of Nishikawa that each of the processes are controlled by processor or CPU.

Nishikawa lacks explicitly disclosing that shielding occurs during the rotation of the variable display device such that a the area of a reel that is to be stopped is in a state that the player can see the symbols on the reel and display areas of other reels that are not to be stopped are in the state that a player can not see the symbols on those reels. However, Minoura discloses such a feature. The Applicant contested in the arguments submitted January 3, 2007 and January

18, 2007, that any attempted modification of Nishikawa's timing of the shielding would violate a principle operation of Nishikawa. However, Minoura discloses a similar end objective to distinguish a winning outcome (i.e. a bi g bonus win) by shielding all symbols that do not occur in the wining line (figure 8 and its related description thereof). In addition to this feature, Minoura also discloses the use of a liquid crystal display in front of a variable display device, similar to Nishikawa, during the spinning of the reels, such that the liquid crystal display shields all symbols while they're being rotated until a player actuates a stop switch corresponding to the reel to which the player wants stopped. Minoura goes on to disclose that each of the reels display a "STOP" image corresponding to a stop switch to stop the reels (figure 7 and its related description thereof). Therefore, the modification of Nishikawa based on the teachings of Minoura would not violate the principle of the operation of Nishikawa as the end objective remains in tact, with additional steps to obtain said end objective as taught by Minoura. The liquid crystal display of Nishikawa is completely capable of performing such a step and only requires routine skill in the art to program. Both references are analogous and provide similar inventions regarding liquid crystal displays disposed in front of variable displays. Motivation to add the teachings of Minoura to Nishikawa stems from the knowledge of one of ordinary skill in the art that players of gaming machines enjoy mystery and excitement, thus, when shielding the reels during rotation provides the sense of mystery and provides for an increased gaming experience. See also paragraphs 0023-0034 of Minoura.

With respect to claims 5-8, it was discussed and explained in the office action mailed April 27, 2006, that the electronic shutter is merely considered a second transparent liquid crystal display used for the purpose of shielding only. It was further discussed that adding a second transparent liquid crystal display involves only routine skill in the art (see the rejection, pages 5-6,

office action mailed 4/27/06). The explanation of the previous rejection is incorporated herein. Thus, it can be seen that the above discussion of modifying Nishikawa with the teachings of Minoura applies to claim 5, where the electronic shutter performs similar task as shielding device of claim 1. The [electronic] shutter is then the display that performs the shielding as described in Minoura, where the electronic shutter a transparent liquid crystal display that is substantially flat and substantially transparent.

Claims 2: The liquid crystal display is considered an electronic shutter, as the display is a video display and "shutters" or blocks visibility of symbols.

Claims 3 & 4: Nishikawa discloses the structure of the liquid crystal display capable as the shielding means for shielding the contents of the variable display, which is capable shielding via an effect display or bonus game. Thus, the shielding control means would control the shielding means to overlay the bonus game. The liquid crystal display is considered an electronic shutter, as the display is a video display and "shutters" or blocks visibility of symbols.

Claim 9: Nishikawa discloses a lamp or light behind the display such symbols can be highlighted via illumination (paragraph 004).

Response to Arguments

Applicant's arguments with respect to the double patenting rejection have been fully considered but are not persuasive. See the double patenting section for a response and additional details to more clearly show a case of double patenting.

Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection. Additionally, a response to arguments is incorporated in the updated

rejections above, where the Examiner responds to the Applicants assertion that modifying Nishikawa may violate the principle operation of the invention. See the rejections above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. An older reference, U.S. Patent No. 4,718,672, issued to Okada (appears to be the Applicant) discloses a liquid crystal display disposed in front of a variable display device.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Scott E. Jones

SCOTT JONES
PRIMARY EXAMINER

M.B.S.